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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/821,923

04/12/2004

Kazuhiko Oonishi

KATA-190

2125

217 7590 02/23/2007  
FISHER, CHRISTEN & SABOL  
1725 K STREET, N.W.  
SUITE 1108  
WASHINGTON, DC 20006

EXAMINER

DOUYON, LORNA M

ART UNIT

PAPER NUMBER

1751

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/821,923	<b>Applicant(s)</b> OONISHI ET AL.	
	<b>Examiner</b> Lorna M. Douyon	<b>Art Unit</b> 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,7-11 and 21-44 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 and 21-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 42-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. This action is responsive to the amendment filed on December 1, 2006.
2. Claims 1, 7-11, 21-44 are pending. Claims 7-11, 21-41 are withdrawn from consideration as being drawn to a non-elected invention. Please note that the "status identifiers" of claims 7-11, 21-41 should have been identified as "Withdrawn".
3. Applicant's election of Group I, claims 1-6, 12-20 in the reply filed on December 01, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
4. The rejection of claims 1-6, 12-20 under 35 U.S.C. 112, second paragraph is withdrawn in view of Applicants' amendment.
5. The rejection of claims 1-5, 12-16 under 35 U.S.C. 102(b) as being anticipated by Kataoka (US Patent No. 4,518,675) is withdrawn in view of Applicants' amendment.
6. The rejection of claims 1-2, 4-5, 12, 14, 16 under 35 U.S.C. 102(b) as being anticipated by Harelstad (US Patent No. 5,073,287) is withdrawn in view of Applicants' amendment.

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7. The rejection of claims 1, 4, 5, 6 and 16 under 35 U.S.C. 102(b) as being anticipated by Sim (US Patent No. 5,411,678) is withdrawn in view of Applicants' amendment.

8. The rejection of claims 1, 4, 5, 6 and 16 under 35 U.S.C. 102(b) as being anticipated by Nercissiantz et al. (EP 0,903,381), hereinafter "Nercissiantz" is withdrawn in view of Applicants' amendment.

9. The rejection of claims 2, 3, 12-15, 17-20 under 35 U.S.C. 103(a) as being unpatentable over Sim as applied to the above claims is withdrawn in view of Applicants' amendment.

10. The rejection of claims 2, 3, 12-15, 17-20 under 35 U.S.C. 103(a) as being unpatentable over Nercissiantz as applied to the above claims is withdrawn in view of Applicants' amendment.

11. The rejection of claims 3, 6, 13, 15, 17-20 under 35 U.S.C. 103(a) as being unpatentable over Harelstad as applied to the above claims in view of Sim is withdrawn in view of Applicants' amendment.

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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12. Claims 1, 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rueter (US Patent No. 5,782,989) in view of JP 62081408.

Rueter teaches a polymer scale removal composition comprising acetone, a minor amount of a strong base, and a minor amount of a hydroxyl- or amino-functional polar organic solvent (see abstract; col. 3, lines 20-23). An example of a strong base is alkali metal alkoxide (see col. 3, line 67 to col. 4, line 3). The polar organic solvent is preferably selected from the group of alcohols, glycols, glycol monoethers, alkylamines and alkanol amines (see col. 4, lines 16-18), for example, n-butanol and ethylene glycol monomethyl ether (see col. 4, line 23-40). The cleaning composition contains little aromatic solvents, and may contain N-methylpyrrolidone in minor quantity (see col. 4, lines 41-48). Rueter, however, fails to specifically disclose sodium ethoxide as the alkali metal alkoxide.

JP 62081408, an analogous art, teaches a polymer removal scale composition comprising alkali metal alcoholate (also known as alkali metal alkoxide) having a formula ROM where M = methyl or ethyl group and M = an alkali metal (see abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to reasonably expect the alkali metal alkoxide of Rueter to include sodium ethoxide because it is known from JP '408 that said sodium ethoxide is a known metal alkoxide or metal alcoholate which is used to remove polymer scale.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

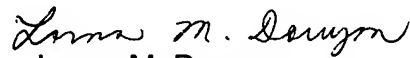
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is 571-272-1313. The examiner can normally be reached on Mondays-Fridays 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Lorna M. Douyon  
Primary Examiner  
Art Unit 1751